

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLN. NO. 09/667,779
ATTORNEY DOCKET NO. Q60742

REMARKS

Applicants request the Patent Office to consider the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on September 22, 2000, and return an initialed PTO-1449 form. Per the Patent Office's request, Applicants have included a copy of the Information Disclosure Statement and PTO-1449 form filed on September 22, 2000, along with the stamped filing receipt.

Claims 1-12 have been examined on their merits, and are all the claims pending in the application.

1. Claims 1-12 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Neilsen (U.S. Patent No. 5,870,548). Applicants traverse the rejection of claims 1-12 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior

art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

With respect to claim 1, Neilsen fails to teach or suggest routing a modification message that modifies a body of a sent e-mail to a server where the sent-email is stored and modifying the body of the sent e-mail if a plurality of addressees have not accessed the e-mail body, wherein the server modifies the e-mail body apart from any e-mail processing means associated with each addressee. While the Patent Office cites col. 15, line 40 to col. 16, line 60 and Figure 11A of Nielsen as allegedly disclosing the modification of the e-mail body prior to its being viewed by any addressees, the cited passages and Figure disclose the modification of an e-mail body by the receiving e-mail system at the recipient's terminal¹, and not the modification of an e-mail body that is stored at a server that is operating independently from any e-mail processing means associated with the e-mail recipient. For example, step 1105 in Figure 11A discloses that the receiving e-mail system stores the received e-mail in the recipient's inbox. *See* col. 16, lines 9-11 of Nielsen. Nielsen further discloses how the text of a received e-mail is modified while stored in the recipient's inbox. *See* col. 16, lines 13-25 of Nielsen. There is no teaching or suggestion in Nielsen, however, that the modification of the e-mail body stored in a recipient's inbox is controlled in any manner based on whether other recipients (*i.e.*, addressees) have viewed the e-mail body. The disclosure of Nielsen is limited to the modification of an e-mail body stored in a particular recipient's inbox, and, unlike the present invention, the modification

¹ "The processing starts at the terminal labeled as 1101 when the receiving e-mail system receives 1103 a message containing an X-Modify: header field." *See* col. 15, lines 47-49 of Nielsen.

of the e-mail body is not dependent upon whether other recipients have viewed the e-mail body prior to the execution of the modification message on the independent server.

Based on the foregoing reasons, Applicants submit that Neilsen fails to teach or suggest all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Neilsen clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicants submit that claim 1 is allowable, and further submit that claim 2 is allowable as well, at least by virtue of its dependency from claim 1. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 1 and 2.

With respect to independent claim 3, Neilsen fails to teach or suggest a server that operates independently from any e-mail processing means associated with a plurality of addressees and comprises means for modifying the body of the sent e-mail if at least one of a plurality of addressees has not accessed the e-mail body stored on the server, wherein the modification is executed independently of any e-mail processing means associated with the plurality of addressees. Neilsen discloses that the e-mail recipient's terminal receives the modification message and the recipient's e-mail program modifies the message. There is no disclosure in Neilsen that the modification of the e-mail body is executed as long as the plurality of addressees has not accessed the e-mail body stored on the server. In fact, Neilsen discloses allowing the e-mail recipient to view the number of changes to the e-mail body, regardless of the number of addressees for that particular e-mail body. *See, e.g.*, col. 16, lines 26-60 of Neilsen. In sum, as noted above with respect to claim 1, the disclosure of Neilsen is limited to the modification of an e-mail body stored in a particular recipient's inbox, and, unlike the present

invention, the modification of the e-mail body is not dependent upon whether other recipients have viewed the e-mail body prior to the execution of the modification message on the independent server.

Based on the foregoing reasons, Applicants submit that Neilsen fails to teach or suggest all of the claimed elements as arranged in claim 3. Therefore, under *Hybritech* and *Richardson*, Neilsen clearly cannot anticipate the present invention as recited in independent claim 3. Thus, Applicants submit that claim 3 is allowable, and further submit that claims 4-10 are allowable as well, at least by virtue of their dependency from claim 3. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 3-10.

With respect to independent claim 11, Neilsen fails to teach or suggest a computer program product that modifies the body of a stored e-mail message addressed to a plurality of addressees as long as the plurality of addressees has not accessed the stored e-mail body, wherein the modification of the e-mail body occurs at a server independently of any e-mail processing means associated with each of the plurality of addressees. Similar to claim 3, there is no disclosure in Neilsen that the modification of the e-mail body is executed on the independent server as long as at least one of the plurality of addressees has not accessed the e-mail body stored on the independent server.

Based on the foregoing reasons, Applicants submit that Neilsen fails to disclose all of the claimed elements as arranged in claim 11. Therefore, under *Hybritech* and *Richardson*, Neilsen clearly cannot anticipate the present invention as recited in independent claim 11. Thus, Applicants submit that claim 11 is allowable, and further submit that claim 12 is allowable as

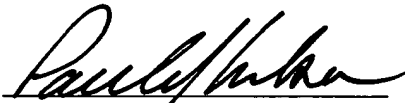
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well, at least by virtue of their dependency from claim 11. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 11 and 12.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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